REMARKS/ARGUMENTS

Claims 1-16 were originally filed in this application. Applicant has not amended or cancelled any of the claims nor added any claims. Claims 1-16 are currently under consideration. Amendment and cancellation of certain claims is not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented.

Concerning the drawings

Applicant submits concurrently herewith replacement drawings in regards to the Notice of Draftsman Patent Drawing Review pursuant to 37 CFR 1.84(i).

Rejection under 35 U.S. C. 101

Claims 1-9 stand provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-283 of copending Application No. 09/928,883. In support of the rejection, the Examiner states:

> "The instant claims appear to be claiming the same invention as that described in the independent claims of the copending application as no structure is claimed for the heat transfer element, the claim is merely drawn to a heat transfer medium on a substrate which is found in the instant claims. In the event the applicant shows that the instant claims are not claiming the same invention then a obviousness type double patenting rejection would apply and appears below."

Obvious-type double patenting rejection

Claims 1-16 stand further provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-283 of copending Application No. 09/928,883 (United States Application Publication No. US2003/0066638). In support of the application the Examiner states:

> "The non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude"

granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F. 3d 1046, 29 USPQ2d 2010 (Fed Cir. 1993), *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214USPQ 761 (CCPA 1982); *In re Vogel*, 422 F2d. 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F2d 528, 163USPQ 611 (CCPA 1969).

"Although the conflicting claims are not identical, they are not patentably distinct from each other because the reduction to practice of the claims of the copending application would render obvious the instant claims...

"The instant claims are claiming the exact same heat transfer medium found in the copending application. Instant claims 1-8 do not recite a substrate whereas the claims of the copending application require a substrate. As for instant claims 9-16, they recite a substrate however they do not recite a heat transfer element, however since the copending claims recite that the heat transfer element is a substrate with a heat transfer medium on it, the instant claims are seen to be encompassed by the claims of the copending application absent evidence showing otherwise."

Applicant disagrees. First of all, the test utilized in determining whether a comparison of claims found in two different applications is quite stringent when it comes to statutory double patenting rejections, under i.e., those 35 U.S.C. 101. Even minor differences between claims in separate applications renders improper the application of a statutory double patenting rejection. For instance, in *Georgia-Pacific Corporation v. United States Gypsum Company*, 195 F.3d 1322, 52 USPQ 2d 1590 (Fed. Cir. 1999), differences in the claims as minor as the two different transition words "consisting" and "comprising" were noted to be of the type that made statutory double patenting rejections between the two applications (or patents) improper. Similarly, even in the instances where the claims of one application dominates the claims of another application, a double patenting rejection, be it statutory or of the judicially created type, may not be appropriate. See, for instance, in *re Kaplan*, 789 F.2d 1574, 229 USPQ 678 (Fed. Cir. 1986). It is also noted that the presence of domination of one set of claims over the other does not preclude finding of judicial double patenting. See, *in re Schneller,* 397 f2d 350, (CCPA 1968).

Applicant notes that the claims in the instant application are drawn variously to a composition (claim 1-8) and to a heat transfer "surface" where a "surface substrate" is covered "at least in part..." by a specific heat transfer medium. As is shown in the copy of claims 1-6 in the Attachment, independent claim 1 is drawn to a "heat transfer element" that is "positioned on a

substrate." Applicant would simply note that one claim is to a surface on a substrate at least partially covered by a heat transfer medium and the other claim is to a structure made up of the heat transfer medium itself.

These are not the same inventions. A statutory double patenting rejection is simply inappropriate.

As to the statutory double patenting aspect of the Office Action, the Office Action has not brought forward a basis upon which a *prima facie* showing that the contents of claims 1-14 in this application are obvious from claims 1-283 of the copending application. Again, as noted in the case law noted just above, an argument that "the instant claims are seen to be encompassed by the claims of the copending application..." is not, in and of itself, sufficient to support a judicial patenting rejection.

Applicant notes that, as to the remainder of the claims in the copending application, of which claims 1-6 are reproduced in their current form in Attachment 1, those other claims are narrower in scope than claims 1-6. The other are believed to be more specific as to their functional uses or to the heat exchanger structures into which the heat transfer medium is placed.

Withdrawal of the rejection is therefore requested along with allowance of the claims.

OTHER REJECTIONS

Applicant notes that no objection of any kind has otherwise been applied against the claims.

CONCLUSION

Applicants have responded to each matter of substance raised in the Office Action and believe the case is in condition for allowance. Should the Examiner have any requests, questions, or suggestions, he is invited to contact applicants' attorney at the number listed below.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, Applicant(s) petition(s) for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 458172000500.

Dated: October 3, 2003

Respectfully submitted,

By E. Thomas Wheelock

E. Thomas Wheelock
Registration No.: 28,825
MORRISON & FOERSTER LLP
755 Page Mill Road
Palo Alto, California 94304
(650) 813-5739
Attorneys for Applicant